

Docket No. 408445

**REMARKS**

Claims 1-16 and 17-21 are pending in the application. Claims 1-4, 6, 7 and 10-16 are currently amended. Claim 17 has been canceled.

Claims 1 and 4 have been amended to add a further limitation that the two direct repeats of a gene of interest from an organism other than yeast. The original specification discloses that the direct repeats of a gene of interest may include, but are not limited to, genes which are not normally present in the transformed plants, and may also include any other genes or DNA sequences which are desirable (See paragraph 36 of the original application). Therefore, these amendments do not introduce new matter into the application by adding a further limitation to the claims.

**Claim Rejections—35 U.S.C. §103(a)**

Claims 1, 4, 6, 10, 12, 14, 15, 17 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 6,534,315 issued to Bauer, and in view of Ow (WO 93/01283). Applicant respectfully disagrees with Examiner because the cited references taken as a whole do not teach or suggest all the claim limitations of the present claims.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." See MPEP 2143.03. Applicant agrees with Examiner in that Bauer teaches a genetic construct comprising a positive selectable marker, a negative selectable marker and direct repeat sequences (or DRSs) of a gene of interest. Applicant also agrees with Examiner in that the DRSs taught in Bauer may be native or non-native to the host strain. However, as Examiner states in the instant Office Action, Bauer teaches that the DRSs should consist of yeast DNA (See line 67 of column 6 to line 7 of column 7, "After excision, one of the 2 DRS sequences remains in place in the genome; it is therefore necessary that this sequence consists of yeast DNA, that is to say of DNA belonging to the same genus and preferably to the same species of yeast. As was indicated above, it is also possible to use, as DRS sequences, fragments of a yeast gene which is absent from the industrial yeast host strain to be transformed.") Claims 1 and 4, as amended, recite "two direct repeats of a gene of interest from an organism other than yeast" (emphasis added). This limitation is neither described nor

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suggested by Bauer, which teaches that the direct repeats must be from a yeast strain that belongs to the same genus or same species as the transformed yeast.

Although Ow teaches a method for producing marker-free transgenic plants wherein a selectable marker gene is flanked by site specific recombination sites and excised using a site specific recombinase, nothing is mentioned in Ow that suggests the use of two direct repeats of a gene of interest from an organism other than yeast. Lacking any teaching or suggestion that the two direct repeats are DNA sequences from an organism other than yeast, Bauer and Ow, considered as a whole, do not render the amended Claims 1 and 4 obvious. Claims 6, 10, 12, 14, 15, 17 and 18 depend from either Claim 1 or Claim 4. Withdrawal of the obviousness rejections is respectfully requested.

#### **New Grounds of Objection Necessitated by Amendment**

The Specification is objected to for failing to provide antecedent basis for the claim limitation of "non-native gene." The word non-native has been deleted from the claims.

Claim 17 has been objected to for failing to further limit the base claim 4. Claim 17 has been canceled.

#### **Claim Rejections—35 U.S.C. §112 first paragraph**

Claims 1, 3, 6, 7 and 10-16 stand rejected under 35 U.S.C. §112 first paragraph as failing to comply with the written description requirement. The word "system" has been deleted from the rejected claims and withdrawal of the §112 first paragraph rejections is respectfully requested.

#### **Claim Rejections—35 U.S.C. §112 second paragraph**

Claims 1-7 and 10-18 stand rejected under 35 U.S.C. §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "non-native" has been deleted which renders the instant rejections moot.

Based upon the foregoing discussion, Applicant's attorney submits that the amended

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claims are allowable and respectfully solicits a Notice of Allowance. The Commissioner is authorized to charge any additionally required fees to deposit account 12-0600.

Respectfully submitted,

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